

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on June 22, 2005. Claims 1-3, 10-13, 15, 16, 18-20, 22, and 26-42 are pending in the Application, Claims 1-8, 11-20 and 22-25 stand rejected, and Claims 9, 10, and 21 stand objected to as being dependent upon rejected base claims, but would be allowed if rewritten in independent form. Claims 1, 10, and 15 are amended, Claims 4-9, 14, 17, 21, and 23-25 are canceled without prejudice or disclaimer, and new Claims 26-42 are added by the present Amendment.

The indication of allowable subject matter is noted with appreciation. Claim 1 is amended with the subject matter of Claim 9 and Claim 15 is amended with the subject matter of Claims 17 and 21. Thus, Claims 1-3, 10-13, 15, 16, 18-20, and 22 are now in condition for allowance.

Summarizing the outstanding Office Action, the Specification was objected to because of a minor informality; Claims 1-7, 11-20, and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mehr-Ayin et al. (U.S. Patent No. 5,146,172, hereinafter "Mehr-Ayin") in view of Roberts et al. (U.S. Patent No. 6,570,385 B1, hereinafter "Roberts"); Claim 8 was objected under 35 U.S.C. § 103(a) as being unpatentable over Mehr-Ayin in view of Roberts and further in view of Moore (U.S. Patent No. 4,787,053); Claim 25 was rejected under 35 U.S.C. §. 103(a) as being unpatentable over Mehr-Ayin in view of Roberts and further in view of Bayer et al. (U.S. Patent No. 4,523,457, hereinafter "Bayer").

Applicants thank Examiner Walter Benson for the courtesy of an interview extended to Applicants' representative on September 15, 2005. During the interview, amendments to the claims were proposed, and arguments as hereinafter developed were presented. No

agreement with respect to the claims was reached. Examiner Benson indicated on the interview summary (form PTOL-413) that "Applicants' representative presents arguments on the combination of prior art. Also discussed revised claims provided to the Examiner by fax. In the Examiner's opinion, Claim 27 appears to contain the inventive feature based on Examiner's review without further search."

In reply to the objection to Applicants' Specification, one paragraph of the disclosure has been amended. No new matter is added. Reconsideration of the objection to Applicants' Specification is respectfully requested.

The above-summarized rejections are now moot in view of the instant amendment placing the above-noted claims in condition for allowance. However, in order to expedite prosecution of this application, Applicants are enclosing herein below remarks in support of the patentability of New Claims 26-42.

Applicants have submitted new Claims 26-42, which find non-limiting support on the subject matter originally disclosed as follows: (1) as to Claims 26-29, on page 2, lines 16-27 of the Disclosure; (2) as to Claims 30 and 33-42, support is self-evident from the previously filed claims; and (3) as to Claims 31 and 32, on page 2, lines 16-27, on page 10, lines 1-4, and on page 11, lines 12-15. Therefore, new Claims 26-42 are not believed to raise a question of new matter.¹ Applicants believe Claims 26-29 to be allowable over the cited references in view of their dependency as well as on their own individual merits because none of the cited references teaches or discloses identification connectors that include engine operating characteristics stored therein.

As to the new independent Claim 30, Applicants respectfully submit that Mehr-Ayin and Roberts, neither individually nor in any combination, can support a *prima facie* case of

¹ See MPEP 2163.06 stating that "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

obviousness of the invention recited therein. This is so for at least two reasons. First, even when combined, these references do not teach or suggest all the claimed features. Secondly, there is no motivation to combine the nonanalogous references except by the use of impermissible hindsight, using Applicants' claims as a blueprint, to pick and choose unrelated elements in Roberts to modify Mehr-Ayin in order to deprecate Applicants' claimed invention.

The appliance recited in Claim 30 comprises, among other features, a processor connected to an identification connector receiver, the processor being configured to decode a plurality of information about the engine contained in the decoding circuit of the identification connector, *the plurality of information about the engine including a plurality of engine operating characteristics of a specified engine family or version*; a control device configured to specify which information from the plurality is decoded by the processor; and *a display unit configured to display the plurality of information about the engine decoded by the processor*.

As disclosed in the Specification, in order to obtain better control over the costs of developing and manufacturing engines, engine manufacturers derive families and versions of specific engines from a "basic" engine. These engines have different engine characteristics, as for example, but not as a limitation, different thrust levels, required by the different airplane frames in which the different versions of the basic engine are to be installed. However, the manufacturers of controllers have defined a single type of controller for a basic engine, which controller is capable of functioning with the different versions of a basic engine in a given family. As a result, the controller is parameterized as a function of the family and the version of any particular engine under consideration. For this purpose, an identification connector is used which is secured to the engine and connected to the

controller.² The identification connector is used to authorize or inhibit certain operating characteristics specific to each engine family and version. For example, an engine version or family defined for maximum thrust of 20,000 pounds might be associated with a connector that authorizes thrust up to 22,000 pounds or one that limits thrust to 18,000 pounds. Given that certain components of the engine are not adapted to delivering thrust above 20,000 pounds, or that limiting thrust to 18,000 pounds might prevent takeoff, providing the wrong connector to an engine can have severe consequences.³

Mehr-Ayin discloses a device to identify a turbine engine with a numeric identity that includes, as illustrated in FIG. 1 of Mehr-Ayin, a microprocessor 42, an analog-to-digital converter 40, a voltage source 44, and a plurality of resistors, capacitors, and diodes forming an electronic circuit. In Mehr-Ayin, the connector 96 does not contain any engine characteristics as just explained, ***but it contains only an engine identification number or numerical identity.***⁴ When an identification module is connected to this electrical circuit, voltage potential measurements at points between resistors of known magnitude and the corresponding resistive identification circuits, by the analog-to-digital converter 40, allow the determination of the resistance values of the different resistors in the module by the microprocessor 42. Thus, Mehr-Ayin fails to teach the features of Claim 30 related to ***a plurality of information about an engine including a plurality of engine operating characteristics of a specified engine family or version.***

The outstanding Office Action acknowledges that Mehr-Ayin fails to disclose a display device as recited in new Claim 30 and several other features recited in Claims 3, 4,

² Specification, page 1, lines 14-29.

³ *Id.*, page 2, lines 16-27.

⁴ See, for example, Mehr-Ayin, col. 1, lines 5-12; col. 11, lines 43-50; and the abstract of that reference, emphasis added.

11, 12, 18-20, and 22-24.⁵ Applicants further note that, as to Claims 7 and 16, contrary to what was asserted in the outstanding Office Action, Mehr-Ayin is silent as to any detection of the model of identification connector that is connected to the disclosed engine identification system. Lines 1-4 in the abstract of Mehr-Ayin states that "the identification module and identification determination circuitry are provided for the purpose of identifying an apparatus and electrically determining the identification number of that identified apparatus" and not the detection of the model of the identification module being identified as recited in Claims 7 and 16.

Roberts is cited for disclosing the acknowledged features missing from Mehr-Ayin. Applicants believe that there is no motivation to combine Roberts with Mehr-Ayin. Even if assuming *in arguendo* that such a motivation exists, Roberts does not remedy the above noted deficiency of Mehr-Ayin related to the recited plurality of information about the engine including a plurality of engine operating characteristics of a specified engine family or version.

In addition, Applicants further note that Mehr-Ayin and Roberts could not support a prima facie case of obviousness of new Claim 30 because there is insufficient evidence for a motivation to modify the Mehr-Ayin device by incorporating features from Roberts thereto for the following reasons.⁶

There is no motivation for a person of ordinary skill in the art to rely on the Roberts reference because it is nonanalogous art to that of the Applicants' invention. As noted by the

⁵ See, for example, the Outstanding Office Action, page 4.

⁶ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

Court of Appeals for the Federal Circuit, the test for nonanalogous art is two-pronged. First, the cited reference must be of a different field of endeavor than that of the Applicants' invention. Second, the cited reference must not be directed to the same problem as the Applicants' invention.⁷

Applicants respectfully submit that Roberts is of a different field of endeavor than that of Applicant's invention. Roberts relates to a handheld device used to test the starting/charging system of an internal combustion engine in a vehicle.⁸ Applicants' invention relate to the field of identification connectors used in airplane engines for parameterizing an engine controller. The claimed appliance is configured to read the contents of engine identifying connectors prior to fitting the engine to the airplane and can be used by an operator to verify the programming of modifiable fields. The record is devoid of any evidence, let alone substantial evidence, showing that a person of ordinary skill, seeking to solve a problem in the art of identifying connectors used in airplane engines, would reasonably be expected or motivated to look for a solution in the inapplicable art of automobile starter testing. Thus, Applicants respectfully submit that both prongs of the Oetiker test are met, making Roberts nonanalogous to Applicants' invention and the combination thereof with Mehr-Ayin inappropriate.

In addition, Applicants respectfully disagree with the characterization of several features of Roberts in the outstanding Office Action. In Roberts, the portable tester 10 comprises a handheld, portable enclosure 12 housing an electronic circuit 14 that, among other things, tests the starting/charging system 11 of an automobile engine. One or more user inputs 16, or pushbuttons 18-21, allow a user to interface with the tester 10. A display 24

⁷ In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

⁸ Roberts, col. 1, lines 6-9.

having four lines of twenty characters each, allows the tester 10 to display information to the user.

As such, contrary to what was asserted in the outstanding Office Action, in Roberts, (1) no information contained in contacts of any connectors is displayed in the display 24 since only starter test results as shown; (2) no information encoded in an identification connector is caused to be displayed since the disclosed device displays test results and not any identification of the starter being tested; (3) no starter being tested is removable from the engine since the tests are clearly disclosed as being performed while the engine is running; (4) no processor updating is described in col. 6, lines 58-62; and (5) no RS-232 port is described at col. 6, lines 1-4.

As to the additional combination of Moore and Bayer to Mehr-Ayin and Roberts, Moore and Bayer do not remedy the above-summarized deficiencies of the combination of Mehr-Ayin and Roberts, thus none of the cited references would support a prima facie case of obviousness of new Claim 30.

Based on the above-noted remarks, Applicants respectfully submit that Mehr-Ayin, Roberts, Moore and Bayer, neither individually nor in any combination thereof, could render obvious the invention recited in new Claim 30. New Claims 31-42 should be allowed, among other reasons, as depending either directly or indirectly from new Claim 30, which should be allowed as just explained.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-3, 10-13, 15, 16, 18-20, and 26-42 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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